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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,919	06/21/2001	Rodrigo Munoz	G03.011	6655

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BUCKLEY, MASCHOFF, TALWALKAR, & ALLISON
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EXAMINER

FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 07/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/886, 919

Applicant(s)

Munoz et al

Examiner

D. Felten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/16/2003
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

1
2 1. Receipt of applicant's remarks filed April 16, 2003 regarding the restriction/election is
3 acknowledged. The examiner has withdrawn the restriction requirement upon further
4 consideration of applicant's comments. Claims 1-27 are now pending in the application and are
5 presented to be examined upon their merits.
6
7

Response to Arguments

8
9

10 2. Applicant's arguments regarding claims 1-24 filed December 30, 2002 have been fully
11 considered but they are not persuasive. Applicants have asserted that the '907 (hereinafter
12 "Tom") reference fail to teach or render obvious, embodiments of the present invention as
13 recited in claim 1. In particular, the applicants points out that Tom fails to disclose, suggest or
14 teach a method that includes: "calculating, based at least in part on the application data,
15 expected loss data, or calculating, based at least in part on the expected loss data a return on
16 investment for the application." The applicant further emphasizes that the Tom patent does not
17 disclose "calculating, based upon at least in part on the application, expected loss data, a return
18 on investment for the application." The examiner disagrees with the applicants' assertions.

19 Firstly, applicant applies a more stringent standard to the reference that to the
20 limitations of the claims. This is a reversal of their appropriate roles as the reference is used as
21 a whole as a teaching in light of the level of skill in the art. In particular, the applicant fails to

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1 appreciate the fact that the one of the objects of the Tom invention is to provide a loss model
2 that takes into account the measure of an amount of risk involved (see Tom, col. 2, ll. 8+).
3 Taking the claims in light of applicant's specification, it quite clearly states on page 10, ll. 14-
4 26 that "One or *more* loss models may be used in conjunction with the embodiments of the
5 invention.." . Tom provides an alternative loss model that would have been an obvious
6 alternative to one of ordinary skill in the art at the time of the invention.

7 Secondly, applicant has stated in the specification that, " ...account level forecast
8 models, *may be used* (indefinite) which factor in the risk of one or more termination events
9 occurring. For example....repossession, early payoff, insurance loss, and early turn-in (or
10 "quasi-repossession"). One or *more* loss models estimating the risk of occurrence of these
11 events may be used to assist in the approval of vehicle lease applications." The examiner
12 views repossession, early payoff, insurance loss, and early turn-in(or "quasi-repossession")
13 defined in the specification as a "special case" set of variables that are evaluated in association
14 with risk analysis to measure an amount of risk. Tom's invention provides a "general case"
15 scenario, but also gives specific examples relating to evaluation of variables in association with
16 risk analysis (see Tom, col. 3, ll. 63 to col. 5, ll. 23).

17 Furthermore, expected loss data defined in the specification as repossession, early
18 payoff, insurance loss, and early turn-in (or "quasi-repossession") are notoriously old and well
19 known factors in the termination of loss of a vehicle leasing contract. Tom discloses an
20 embodiment where the invention is used in an automobile leasing application (see Tom, col. 4,
21 ll. 62+). Those who lease vehicles would be familiar with these concepts and have used them
22 in the evaluation process. Therefore official notice is taken of expected loss data as defined in
23 the specification because repossession, early payoff, insurance loss, and early turn-in (or

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1 “quasi-repossession”) are notoriously old and well known factors in the termination of loss of
2 a vehicle leasing contract as well as obvious extensions of the teaching of Tom to evaluate
3 vehicle leasing application risk.

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6 ***Claim Rejections - 35 USC § 103***

7 3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
8 obviousness rejections set forth in this Office action:

9 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
10 section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
11 are such that the subject matter as a whole would have been obvious at the time the invention was made to a
12 person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
13 negated by the manner in which the invention was made.

14
15 4. Claims 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tom (US
16 5,696,907).

17
18 **Re claim 25 and 27:**

19 Tom discloses a method of evaluating an application for a financial product , the method
20 comprising:

21 receiving application data (see Tom, col. 33, ll. 43-62);

22 calculating, based at least in part on the application data, expected loss data (see Tom,
23 at least col. 2, ll. 9-24); and

24 making an application approval decision based on the return investment (see Abstract).

1 Tom fails to disclose, as in claims 25 and 27, calculating, based at least in part on the
2 expected loss data. Tom discloses an embodiment where the invention is used in an automobile
3 leasing application (see Tom, col. 4, ll. 62+). An artisan of ordinary skill in the art at the
4 time of the invention would be familiar with the concepts provided by the applicant in the
5 specification that defines expected loss as “repossession, early payoff, insurance loss, and
6 early turn-in (or “quasi-repossession”) and have sought to evaluate these variables to assess
7 application risk. Therefore official notice is taken of expected loss data as defined in the
8 specification because repossession, early payoff, insurance loss, and early turn-in (or “quasi-
9 repossession”) are notoriously old and well known factors in the termination of loss of a
10 vehicle leasing contract as well as obvious extensions of the teaching of Tom to evaluate
11 vehicle leasing application risk.

12
13 **Re claim 26:**

14 wherein the making an application approval decision further comprises: comparing the return
15 on investment with the expected return on investment (see Tom, Abstract) .
16
17

18 **Re claim 27:**

19 An apparatus for evaluating an application for a financial product, apparatus comprising:
20 a processor; a communication device, coupled to the processor, receiving application data from
21 at least a first user device; and a storage device in communication with the processor and
22 storing instructions adapted to be executed by the processor to: calculate, based at least in part
23 on the application data, expected loss data; calculate, based at least in part on the expected loss

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1 data, a return on investment for the application; and make an application approval decision
2 based on the return on investment (see Tom, col. 6, ll. 47+).

3
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5 **Conclusion**

6
7 5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time
8 policy as set forth in 37 CFR 1.136(a).

9 A shortened statutory period for reply to this final action is set to expire THREE
10 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO
11 MONTHS of the mailing date of this final action and the advisory action is not mailed until after
12 the end of the THREE-MONTH shortened statutory period, then the shortened statutory period
13 will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR
14 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,
15 will the statutory period for reply expire later than SIX MONTHS from the mailing date of this
16 final action.

17
18
19 6. Any inquiry concerning this communication or earlier communications from the examiner
20 should be directed to **Daniel S. Felten** whose telephone number is (703) 305-0724. The
21 examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday.
22 Any inquiry of a general nature relating to the status of this application or its proceedings should
23 be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor
24 **Vincent Millin** whose telephone number is (703) 308-1065.

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1 7. Response to this action should be mailed to:

2
3 Commissioner of Patents and Trademarks

4 Washington, D.C. 20231

5
6 for formal communications intended for entry, or (703) 305-0040, for informal or draft
7 communications, please label "Proposed" or "Draft".

8 Communications via Internet e-mail regarding this application, other than those under 35
9 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be
10 addressed to [*daniel.felten@uspto.gov*].

11 All Internet e-mail communications will be made of record in the application file. PTO
12 employees do not engage in Internet communications where there exists a possibility that
13 sensitive information could be identified or exchanged unless the record includes a properly
14 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly
15 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
16 Trademark on February 25, 1997 at 1 195 OG 89.

17
18
19 

20 **DSF**
21 **July 16, 2003**



HANI M. KAZIMI
PRIMARY EXAMINER